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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/810,965	03/17/2001	Anthony J. Benson	10003438-1	7251

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EXAMINER	
DANG, KHANH NMN	

ART UNIT	PAPER NUMBER
2111	7

DATE MAILED: 02/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/810,965	BENSON ET AL.	
	Examiner	Art Unit	
	Khanh Dang	2111	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *12 December 2003*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-17* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☒ Claim(s) *1-14* is/are allowed.

6)☒ Claim(s) *15-17* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *12/12/2003* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 112

Claims 15-17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claims 15-17, the relationships between the steps set forth in the claims are unclear, since the essential structural cooperation relationships between structural elements from which a method for configuring is performed have been omitted, such omission amounting to a gap between s necessary structural connections.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 15-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pecone et al.

Pecone et al. discloses a bus controller card (22, for example) for use with a backplane having a bus controller slot (see at least Fig. 1, for example) connected to a first bus (A, for example) and a second bus (B, for example), comprising: a first backplane connector (30/72/74 combination, for example) adapted for connection to a

selected one of the first bus (A) and the second bus (B); a second backplane connector (30/72/76 combination) adapted for connection to the other one of the first bus (A) having a first set of pins at connector (30) and the second bus (B) having a second set of pins at connector (30); and a first switchbox comprising a plurality of individual switches (46A, 46B) operationally connected to said first backplane connector (79) and said second backplane connector (80), wherein one of said switches (46A, 46B) controls bus addressing on said first bus and another one of said switches (46A, 46B) controls bus addressing on said second bus (B) independent of the particular said backplane connector connected to each bus. Pecone et al. further discloses a cable sensor (50) for detecting a signal at one of the backplane connectors. In summary, Pecone et al. discloses the claimed invention including the use of one "controller card" (22) with two "backplane connectors," two "host connectors," a Y-cable and switches. However, Pecone does not disclose the use of two "controller cards," two "backplane connectors," two "host connectors," two cables and switches, It would have been obvious to one of ordinary skill in the art at the time the invention was made to employ two "controller cards" with two cables, two "backplane connectors," two "host connectors," since the Examiner takes Official Notice that a selection between a combination of two host connectors connected to one terminal through a Y-cable and switches and a combination of two host connectors connected to two terminal through two single cable and switch(s) is clearly within the level of skill in the art. In any event, it has been held that constructing a formerly integral structure in various elements involves only routine skill in the art. *Nerwin v. Erlichman*, 168 USPQ 177, 179. Note also

that orientation/placement of the cards and relative setting of switches is merely a design choice.

Response to Arguments

Applicants' arguments filed 12/12/2003 have been fully considered but they are not persuasive.

At the outset, Applicants are reminded that claims subject to examination will be given their broadest reasonable interpretation consistent with the specification. *In re Morris, 127 F.3d 1048, 1054-55 (Fed. Cir. 1997).* In fact, the "examiner has the duty of police claim language by giving it the broadest reasonable interpretation." *Springs Window Fashions LP v. Novo Industries, L.P.,* 65 USPQ2d 1862, 1830, (Fed. Cir. 2003). Applicants are also reminded that claimed subject matter not the specification, is the measure of the invention. Disclosure contained in the specification cannot be read into the claims for the purpose of avoiding the prior art. *In re Sporck*, 55 CCPA 743, 386 F.2d, 155 USPQ 687 (1986).

With this in mind, the discussion will focus on how the terms and relationships thereof in the claims are met by the references. Response to any limitations that are not in the claims or any arguments that are irrelevant and/or do not relate to any specific claim language will not be warranted.

The 35 USC 112, 2nd paragraph Rejection:

The rejection of claims 1-14 is hereby withdrawn in view of Applicants' amendments to the claims.

Applicants' amendment to claim 15 does not overcome the rejection.

Applicants did not provide any separate argument regarding claims 15-17, and any reason why the amendment should overcome the rejection.

The 35 USC 103 Rejection:

In response to Applicant's arguments, page 11, against the Pecone individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of Pecone and common knowledge in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

In response to Applicants' argument regarding the Official Notice, MPEP 2144.03 clearly states that "it might not be unreasonable to take official notice of the fact that it is desirable to make something faster, cheaper, better, or stronger without the specific support of documentary evidence. Furthermore, it might not be unreasonable for the examiner in a first Office action to take official notice of facts by asserting that certain limitations in a dependent claim are old and well known expedients in the art without (emphasis added) the support of documentary evidence provided the facts so noticed are of notorious character and serve only to 'fill in the gaps'." Further, MPEP 2144.03(c)

also clearly states that in order to "adequately traverse such a finding, an applicant must specifically point out the supposed errors in the examiner's action, which would include stating why the noticed fact is not considered to be common knowledge or well-known in the art. See 37 CFR 1.111(b). See also Chevenard, 139 F.2d at 713, 60 USPQ ... A general allegation that the claims define a patentable invention without any reference to the examiner's assertion of official notice would be inadequate."

Thus, in light of the MPEP 2144.03, it is clear that a mere allegation such as, "[t]he applicants further traverse the rejections on the basis that the applicants claim more than the mere usage of pairs of the controller cards, backplane connectors, host connectors, and the like, that would be subject to Official Notice..." (Applicants' remark, page 12), is not adequate and does not shift the burden to the Examiner to provide evidence in support of the Official Notice. Allowing such a statement to challenge Official Notice would effectively destroy any incentive on the part of the Examiner to use it in the process of establishing a rejection of notoriously well-known facts. In the instant case, as noted above, Applicant has not provided any adequate information or argument so that on its face it creates a reasonable doubt regarding the circumstances justifying the Official Notice. Therefore, a presentation of a reference/document to substantiate the Official Notice is not deemed necessary. The Examiner's taking of Official Notice has been maintained.

Allowable Subject Matter

In view of Applicants' amendments, arguments, and upon further review of Pecone, claims 1-14 are now allowed .

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication should be directed to Khanh Dang at telephone number 703-308-0211.

Khanh Dang
Primary Examiner